

REMARKS

Specification

The specification has been amended at page 6 to correct obvious typographical errors (*i.e.*, correction of the spelling of the word “dispersant”) in a chemical scheme and to correct misidentification of an enamine group as a ketimine group, and a ketimine group as an enamine group. A person of ordinary skill in the art would recognize this misidentification as an error that does not add prohibited new matter to the specification.

Claims

Claims 1, 3, 4, 6, 14, 16 and 19-22 have been amended and claim 2 has been cancelled without prejudice or disclaimer of the encompassed subject matter.

Claim 1 has been amended to relate to encapsulated, rather than modified, particulate solids and now recites that the compound is a cross-linking agent and the dispersant has certain specific cross-linkable groups. Representative support in the specification for these amendments to claim 1 may be found, for example, in claim 2, now cancelled, and at page 2, lines 26 to 34.

The amendments to claims 3, 4 and 6 (that the compound is a cross-linking agent) were made to conform to amended claim 1, from which each of claims 3, 4 and 6 depends.

In amended claim 14, the term “obtainable” has been deleted to better clarify claim scope.

In amended claim 16, the recitation of a reaction has been deleted for consistency with amended claim 1, from which claim 16 depends.

In amended claim 19, the term “modified” has been replaced with “encapsulated” for consistency with amended claim 1, from which claim 19 depends.

In amended claim 20, the term “compound” has been replaced with “cross-linking agent” for consistency with amended claim 1, from which claim 20 depends.

In amended claim 21, the term “modified” has been replaced with “encapsulated” for consistency with amended claim 1, from which claim 21 depends. The term “obtainable” has also been deleted to improve clarity.

In amended claim 22, the term “modified” has been replaced with “encapsulated” for consistency with amended claim 1, from which claim 22 indirectly depends.

In view of the above discussed representative support for each of the claim amendments, Applicants submit that no prohibited new matter has been added by any of the amendments.

1. **Election**

In response to the restriction requirement, Applicants elect with traverse the invention of Group II as defined by the Examiner on page 2 of the Restriction Requirement – *i.e.*, claim 21, drawn to an encapsulated particulate solid (as amended). The election is made “with traverse”, however for at least the following reasons.

The Examiner alleges that the process recited in claim 1 “does not define a contribution over the prior art as evidenced by Kato (US 5,348,997)” for the reasons provided on pages 2-3 of the Office Action. The Examiner goes on to allege that this lack of contribution means that the claims do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack a common special technical feature and therefore are non-unified.

Applicants respectfully submit that Kato does not disclose the particulate solids as required by previously pending or currently amended claim 1. Previously pending claim 1 required a "modified" pigment prepared by reacting a dispersant and a compound. In stark contrast, Kato prepares a dispersion which is reactable (*i.e.*, cross-linkable) but not reacted (*i.e.*, cross-linked). The reaction only takes place when the dispersion is printed onto the substrate. Thus, modified (encapsulated) particulate solids are not prepared by Kato. Evidence that this is the correct understanding of Kato can be found in the following 3 points:

1. **Kato uses the word cross-linking (= cross-linkable), not cross-linked.**

In Kato the word cross-linking is used to identify a dispersion which has the potential to cross-link once printed onto a substrate. See, *e.g.*, Kato at Abstract, column 1, line 7; column 1, lines 37 and 41; column 6, line 48; column 7, line 20; column 8, line 34; and column 15, line 44.

2. **Kato clearly teaches hardened coating films.**

To harden a coating requires reaction only after the film has formed. Any pre-reaction would prevent or inhibit the formation of the film in the first place. See, *e.g.*, Kato at column 3, line 64; column 4, line 20; column 7, line 12 and column 15, line 46.

3. Kato shows experimentally that its dispersions do not change viscosity after storage

Kato prefers aqueous resin dispersions (A) which also contain a carbonyl group. See, *e.g.*, Kato at column 2, lines 20 to 35. In these embodiments of the aqueous resin (A), the carbonyl-containing copolymer resin (C) and the hydrazine derivative are all co-reactive. See, *e.g.*, Kato at column 2, lines 36 to 51. The dispersion is so co-reactive (because a keto functional resin dispersion is used) that if reaction occurred in the liquid phase, viscosity increases or gelling would be expected. Table 4 of Kato shows that embodiments using both keto functional resin dispersions (A) and carbonyl-containing copolymer (C) resulted in no signs of viscosity increase. Thus, consistent with points 1 and 2 above, in point 3, Kato shows experimentally why it does **not** teach reacted (*i.e.*, cross-linked) dispersions but instead teaches dispersions which react after printing and film formation.

Once the dispersions of Kato have dried on a substrate to form a film they are, of course, no longer in a particulate form as required by Applicants' previously pending claim 1. Accordingly, it is respectfully submitted that Kato does not disclose modified or reacted particulate solids according to previously pending claim 1.

In the current response, claim 1 has been amended merely to clarify terms such as "modified", "compound" and "reacted" so as to better define the intended scope of claim 1. Compared to claim 1 as amended, Kato does not disclose encapsulated or cross-linked particles at least for the same reasons discussed above. In fact, Applicants submit that the distinction of Applicants' claimed invention over Kato is even easier to appreciate in view of the refined language of claim 1. Thus, both the previous and the presently amended claims are distinguishable over Kato and thus are unified. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn as it pertains to claims 21 to 29, or at least claims 21 to 24 and 29.

Applicants understand that since a product claim has been elected, the withdrawn process claims will be available for rejoinder if an allowable product claim is identified by the Examiner and the process claims are limited to the features of the allowable product claim.

2. Information Disclosure Statement

An Information Disclosure Statement is being filed concurrently with this response. Applicants respectfully requests that the Examiner consider the documents listed on the accompanying Form PTO-1449 and acknowledge said consideration.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or to credit any overpayment to Deposit Account No. 50-0310.

Respectfully Submitted,
Morgan Lewis & Bockius LLP

Date: **October 6, 2010**
Morgan Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel. No.: 202-739-3000
Fax No.: (202) 739-3001

By: /Gregory T. Lowen/
Gregory T. Lowen
Registration No. 46,882
Direct: (202) 739-5915